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Patent

Case No.: 56729US002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: VANDENAVOND, TODD M.

Application No.: 09/893823 Group Art Unit: 3621

Filed: June 28, 2001 Examiner: Cristina A. Sherr

Title: PACKAGE LABELING

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

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December 16, 2005 *Virginia Bergstrom*
 Date Signed by *Virginia Bergstrom*

Dear Madam:

This is in response to the Office Action mailed November 16, 2005. Claims 1-60 are pending. Claims 1-4, and 6-60 were restricted under 35 USC § 121 as follows:

- I. Claims 1-4, 13-17 are said to be drawn to a database for storing label records and data, classified in Class 707, subclass 100;
- II. Claims 7-12 are said to be drawn to too storage of label records and data without use of a database, classified in Class 711, subclass 1;
- III. Claims 18-23 are said to be drawn to a method for storing label records with an interface for setting status of said records, classified in Class 715, subclass 700;
- IV. Claims 24-30 and 48-56 are said to be drawn to label management system and method for storing configuration data, classified in Class 705, subclass 500;
- V. Claims 31-40 are said to be drawn to a database for the storing, archiving and printing label records, classified in Class 708, subclass 204;
- VI. Claims 41-44 are said to be drawn to a label template defining fields for data, classified in Class 715, subclass 500;
- VII. Claims 45-57 are said to be drawn to a label management system with database and template design tools, classified in Class 707, subclass 100;

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VIII. Claims 57-60 are said to be drawn to a label management system with central storage and remote access for printing, classified in Class 707, subclass 10.

Election

Applicant first notes that claim 5 has not been included in any group, and claim 57 is included in both groups VII and VIII.

In support for the restriction, the Examiner cited MPEP 806.05(e) which states that process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another materially different process. The Examiner then stated, "In this case, each of the different methods as claimed can be practiced at least partially by hand."

Applicant hereby traverses this restriction. First, Examiner did not restrict *between* a process and its associated apparatus (as would have been appropriate per MPEP 806.05(e)). Rather, Examiner restricted *among* processes, articles, and systems, resulting in groupings that have various combinations of these three subject matters. For example, group II contains a method, and VII includes a label management system, a label management software system, a method, a computer-readable medium, and a label management system. For this reason alone, the restriction requirement is improper.

Second, if the restriction were proper under 806.05(e), it is not enough that a process contain one of a plurality of steps that can be practiced by hand. By the Examiner's own words, "each of the different methods as claimed can be practiced at least partially by hand." For a process claim to be distinct from an apparatus claim, MPEP 806.05(e) does not provide that anything less than the entire process claim must be practiced by hand, i.e., without interaction with the elements required by the apparatus claim. In other words, "partially by hand" does not equal the "by hand" standard as specified in 806.05(e), and a process claim reciting steps of interacting with an apparatus (by hand or otherwise) is not considered independent and distinct from an apparatus claim under 806.05(e).

In light of the two points above, Examiner has provided no reason why her proposed groupings are independent and distinct, as required by MPEP section 800, and are thus seen to be arbitrary and in error. Further, Applicant notes that the Examiner's Notes of section 806.05(e)

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provides that it is the Examiner's burden to provide reasonable examples that recite material differences. Examiner has provided no examples (reasonable or otherwise) of her application of 806.05(e) to any of her groupings. Rather, she has arbitrarily grouped claims and then inappropriately referenced 806.05(e) as authority for her grouping.

To the extent the Examiner maintains the restriction in view of the above-described errors, Applicant elects Group IV with traverse. Continued prosecution of this application is respectfully requested.

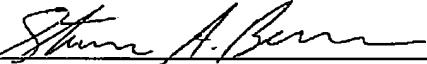
It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

Date

December 16, 2005

By:



Steven A. Bern, 57,095

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Office of Intellectual Property Counsel
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